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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,772	11/17/2003	Albert A. Zofchak	A17-060	2422
7590	06/14/2007		EXAMINER	
Henry D. Coleman COLEMAN SUDOL SAPONE, P.C. 714 Colorado Avenue Bridgeport, CT 06605-1601			QAZI, SABIHA NAIM	
			ART UNIT	PAPER NUMBER
			1616	
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			06/14/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/714,772	ZOFCHAK ET AL.
	Examiner Sabiha Qazi	Art Unit 1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 17 May 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
  - 4a) Of the above claim(s) 10-16 and 20 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-9 and 17-19 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**Non-Final Office Action**

Claims 1-20 are pending. No claim is allowed at this time. Election of group I with traverse is hereby acknowledged.

**Summary of this Office Action dated Monday, June 11, 2007**

1. Information Disclosure Statement
2. Copending Applications
3. Specification
4. 35 USC § 103(a) Rejection
5. Communication

### **Information Disclosure Statement**

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### **Copending Applications**

Applicants must bring to the attention of the examiner, or other Office official involved with the examination of a particular application, information within their knowledge as to other copending United States applications, which are "material to patentability" of the application in question. MPEP 2001.06(b). See Dayco Products Inc. v. Total Containment Inc., 66 USPQ2d 1801 (CA FC 2003).

### **Specification**

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

**Claim Rejections - 35 USC § 103**

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-9 and 12-17 rejected under 35 U.S.C. 103(a) as being unpatentable over EMMONS et al.<sup>1</sup>; Jones, Charles E<sup>2</sup>. All these references teach urethane derivatives useful for personal care products which embraces presently claimed invention.

EMMONS teaches molecular weight thickeners, characterized by hydrolytic stability, versatility and efficiency, and to a wide variety of aqueous systems containing the thickeners.

The thickeners of this invention provide a combination of properties not found in any one class of known thickeners. For example, they are nonionic and in many cases are highly efficient viscosity improvers although having a relatively low molecular weight. They are stable to water and alcohol and are not sensitive to biodegradation. They are versatile in that not only do they thicken virtually unlimited types of aqueous systems, but they also impart many of the auxiliary properties described above. Thus, as additives to textile binder compositions, they actually soften rather than harden the fabric. In latex paints, especially, they not only thicken but in many cases also provide superior flow and leveling, and give excellent viscosity control under both low and high shear conditions.

The reference further teaches that urethane polymers having at least three low molecular weight hydrophobic groups at least two of which are terminal (external) hydrophobic groups. Many of the polymers also contain one or more internal hydrophobic groups. The hydrophobic groups together contain a total of at least

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<sup>1</sup> US Patent 4,079,028

20 carbon atoms and are linked through hydrophilic (water soluble) groups containing polyether segments of at least about 1,500, preferably at least about 3,000, molecular weight each so that the polymers readily solubilize in water, either by self-solubilization or through interaction with a known solubilizing agent such as a water miscible alcohol or surfactant. The molecular weight of the polyurethanes is of the order of about 10,000 to 200,000.

The hydrophobic groups of the polyurethanes occur in the residues of reactants (b) and (c) and may also occur in the residue of reactant (d) if present. The terminal (external) hydrophobes are the residues of the monofunctional active hydrogen compounds, organic monoisocyanates, or combinations of the residues of such compounds. The polymers may be substituted for known thickeners in any aqueous system in which thickeners are normally utilized and therefore the fields of use of the thickeners of the invention include a host of industrial, household, medical, **personal care** and agricultural compositions. The thickening in such compositions is often also accompanied by other improvements, such as leveling, flow, stabilization, and suspension; high and low shear viscosity control, and binding properties. See the entire document especially abstract, and summary of the invention, Example 280 (drawn to cosmetics) and example 281 drawn to useful protein hair conditioner.

JONES teaches a method of thickening a hair dye composition comprising at least one polyethoxylated urethane. See the entire document especially [0016], [0019][0021, [0023].

Instant claims differ from the reference in claiming a method of use of specific urethanes for personal care products wherein prior art teaches other uses including the use in personal care products.

It would have been obvious to one skilled in the art to prepare additional beneficial compositions to prepare personal care products with increased viscosity because prior art teaches the same. One skilled in the would be motivated to use urethane derivatives in order to adjust or increase the viscosity of any personal care products. Applicants in the disclosure have no showing of any criticality or any new use.

In the light of the forgoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the instant claims would have been obvious within the meaning of 35 U.S.C. 103(a).

#### **Response to Remarks**

- Arguments were fully considered but were not found persuasive therefore restriction is maintained. Examiner respectfully disagree because each invention is separate and a reference used to reject subject matter of one group may not be used to reject any other group.

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- In order to advance the prosecution Applicant may consider calling the Examiner to discuss the issues surrounding this application.

**Communication**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha Qazi, Ph.D. whose telephone number is 571-272-0622. The examiner can normally be reached on any business day.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter, Ph.D. can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SABIHA QAZI, PH.D  
PRIMARY EXAMINER